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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,553	01/05/2004	Anthony Waterworth	5722-2	2411
7590	08/24/2005			EXAMINER
Woodard, Emhardt, Moriarty, McNett & Henry LLP Bank One Center/Tower Suite 3700 111 Monument Circle Indianapolis, IN 46204-5137			TRIEU, THERESA	
			ART UNIT	PAPER NUMBER
			3748	
			DATE MAILED: 08/24/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/751,553	WATERWORTH ET AL.	
	Examiner	Art Unit	
	Theresa Trieu	3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 June 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to the applicants' amendment filed on March 30, 2001.

Claims 1, 5, 12 and 14 have been amended. Claim 16 has been canceled. Claims 1-15 are pending in this application.

Applicants' cooperation in amending the claims to overcome the claim rejection 35 USC 112 as being indefinite is also appreciated. However, a few minor informalities contain in claim 1.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

1. The drawings were received on June 6, 2005. These drawings are acknowledged.

Oath/Declaration

2. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. The claim 1 is broader than the original claim 1 since the applicant had removed the elements of "a reservoir for the feed pump and a sump and reservoir for the scavenging pump" (see page 8, line 8 and 9). A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 16, the phrase "the bores are provided with a first end opening on a first side of the body" renders the claim indefinite because it is unclear which side of the body is a first side (i.e. underside or upper side or lower side or on a side), as applicant has claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. *Claims 1 and 4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Waterworth (Patent Number 4,758,130) in view of legal precedent.*

Regarding claims 1 and 4-10, as shown in Figs. 6-10, Waterworth discloses an apparatus for movement of fluid, the apparatus including a feed pump (see col. 5, line 14-18) and scavenge pump (86), each of the pumps including inner and outer (91, 93 - 89, 87) rotary pump members housed in respective pump chambers in a body portion, a drive shaft (82) being common to the inner rotary pumping chambers (91, 89) of the feed and scavenge pumps; inlet and outlet bores (90, 92; 94, 96) in connection with respective feed and scavenge pump chambers, wherein each of the bores (90, 92; 94, 96) being provided with a first end opening on side of the body (see Fig. 9) and an opposing end terminating at a respective pump chamber; the inlet and outlet bores (90, 92; 94, 96) being shaped to curved with respect to at least two of the x, y, z axes (see Fig. 9); the operation of the respective feed and scavenge pump being staggered in an episoidal manner; the operation of the feed and scavenge pumps being sequential. Note that in claim 1, the limitation “*for use in conjunctionscavenging pump*” and “*such that the liquids enters the body portion.....of the driveshaft*” are an intended use and functional implication. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). However, Waterworth fails to disclose the body portion formed by casting.

Regarding claim 1, a claim for an article capable of such definition must define the article by its structure and not by the process of making it. Since the claimed the body portion is capable of structural definition, the patentability of the claims must be determined solely on the basis of recited structure, exclusive of process recitations. *In re Johnson*, 394 F.2d 591, 157 USPQ 620, 55 CCPA 1463.

Applicants should also note that where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an obvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed.Cir. 1983). Accordingly, the cast body portion do not result in any different structure than shown by the applied prior art.

5. *Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waterworth '130 in view of legal precedent.*

Waterworth discloses the invention as recited above; however, Waterworth fails to disclose the bores are shaped to curve with respect to the three XY and Z axes. It is examiner's position that one having ordinary skill in the pump art, would have found it obvious to utilize the bores being shaped to curve with respect to the three XY and Z axes, since it is merely design parameters, depending on the installation of and the size of the pump and depending on the particular purpose or solves a stated problem. Moreover, there is nothing in the record which establishes that the shaping of the bores with respect to the three XY and Z-axis, presents a novel or unexpected result (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)).

6. *Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waterworth '130 in view of design choice.*

Waterworth discloses the invention as recited above; however, Waterworth fails to disclose the apparatus being provided to be retrofitted as a replacement component to an existing combustion engine.

It is examiner's position that one having ordinary skill in the pump art, would have found it obvious to utilize the apparatus being provided as a replacement component to an existing combustion engine, since they are merely design parameters, depending on the particular purpose or solves a state problem. Moreover, there is nothing in the record which establishes that the claimed apparatus being provided in the combustion engine, presents a novel or unexpected result (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)). Applicants should also note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

7. *Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waterworth '130 in view of legal precedent.*

Waterworth discloses the invention as recited above; however, Waterworth fails to disclose the components of the arrangement is sintered and heat treated to provide resistance to wear. However, where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an obvious difference between the two.

See In re Marosi, 218 USPQ 289 (Fed.Cir. 1983).

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicants' argument that the Waterworth '130 show the bores can only made to curve about single axis. The examiner respectfully disagrees. Waterworth '130 teaches that the bore (90, 92; 94, 96) being shaped to curved with respect to at least two of the x, y, z axes (see Fig. 9), [emphasis added].

In response to applicants' argument that the reference fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *the orientation of the pump as now claimed....required to be directly driven by the engine shaft and a gearing* (see Remark section, page 12, 2nd paragraph, line 7-10)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

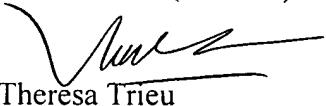
Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm. The new telephone number is 571-272-4868 that will become effective after November 22, 2004.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The new telephone number is 571-272-4859 that will become effective after November 22, 2004. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT
August 20, 2005


Theresa Trieu
Primary Examiner
Art Unit 3748